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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,184	07/14/2006	Giuseppe Bordignon	6706/004	7294
22440	7590	03/05/2009	EXAMINER	
GOTTLIEB RACKMAN & REISMAN PC			DONDERO, WILLIAM E	
270 MADISON AVENUE				
8TH FLOOR			ART UNIT	PAPER NUMBER
NEW YORK, NY 10016-0601			3654	
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			03/05/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/597,184	BORDIGNON ET AL.	
	Examiner	Art Unit	
	WILLIAM E. DONDERO	3654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 December 2008.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 21-40 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 21-40 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 14 July 2006 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed September 29, 2006 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A complete copy of the Japanese reference, JP62275980A, was not provided, only a translated abstract was provided.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-31 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bordignon et al. (US-6318660) in view of Fredriksson (US-3472461). Regarding Claims 21, 24 and 26, Bordignon et al. disclose a device 10 for coiling windable long, metal product comprising a mandrel 25 having a substantially circular traverse section, and at least a guide and containing device 39,40 able to be driven between a first working position (Figure 2) in which the guide and containing device cooperates with the mandrel, and a second inactive position (Figure 3) in which the guide and containing device is arranged distant from the mandrel (Figures 1-3).

Bordignon et al. are silent about at least a clamping device associated with the mandrel, and able to clamp at least temporarily an initial segment of the metal product, wherein the clamping device comprises pincer means able to be selectively activated, which are arranged in correspondence with the outer surface of the mandrel in an inner position with respect to the outer surface of the mandrel, the pincer means further being provided to radially thrust the metal product; and an actuator device able to act on the respective arms of the pincer means, in order to perform the selective activation of the pincer means. However, Fredriksson discloses a device for coiling windable long, metal product 13 comprising a mandrel 10 having a substantially circular traverse section, and at least a clamping device 12,13, 14 associated with the mandrel, and able to clamp at least temporarily an initial segment of the metal product, wherein the clamping device comprises pincer means 14 able to be selectively activated, which are arranged in correspondence with the outer surface of the mandrel in an outer position with respect to the outer surface of the mandrel, the pincer means further being provided to radially thrust the metal product; and an actuator device 50 able to act on the respective arms 19,16,48,49 of the pincer means, in order to perform the selective activation of the pincer means (Figures 1-6). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the pincer means to the device of Bordignon et al. to secure the initial end of the metal product as taught by Fredriksson (Column 2, Lines 39 - 52). Regarding Claim 22, Bordignon et al. disclose the guide and containing device comprise means able to displace the metal product towards the clamping device (Figures 1-3 and Column 4, Lines 10-13). Regarding Claim 27, Bordignon et al.

disclose an inner plate (behind 24) provided to define one of the lateral walls between which the metal product is wound (Figures 1-3). Regarding Claims 28, Bordignon et al. disclose the inner plate defines an annular channel (between the surface of 25 and the bottom edge of the inner plate) in proximity with the outer surface of the mandrel (Figures 1-3). Regarding Claims 29-31, Bordignon et al. disclose the guide and containing device comprises a first flap 39 and a second flap 40 diametrically opposite the first flap constituting, in the first working position, a later cover to the annular channel (Figures 1-3).

Regarding Claim 23, Bordignon et al. in view of Fredriksson is silent about the pincer means being arranged in an inner position with respect to the outer surface of the mandrel. However, one of ordinary skill in the art at the time of the invention would recognize it would have been an obvious design choice to move the pincer means to an inner position with respect to the outer surface of the mandrel to keep the pincer means from being in the way of the winding wire.

With respect to claim 25, Bordignon et al. in view of Fredriksson does not disclose specific values for number of pincer means. However, one of ordinary skill in the art is expected to routinely experiment with the parameters, especially when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been obvious through routine experimentation and optimization, for one of ordinary skill in the art to use as many pincers, such as four, as necessary to equally hold and secure the metal product to the mandrel.

Regarding Claim 37, Bordignon et al. disclose a method for coiling a long metal product, performed by means of a coiling device 10 which comprises a mandrel 25 having a substantially circular traverse section and rotating around a horizontal axis, and at least a guide and containing device 39,40 able to be driven between a first working position (Figure 2) in which the guide and containing device cooperates with the mandrel, and a second inactive position (Figure 3) in which the guide and containing device is arranged distant from the mandrel, the method comprising a first step wherein a leading end of the metal product is inserted into a groove 41 of the guide and containing device arranged in the first working position, so as to guide the metal product along an outer surface of the mandrel; a third step wherein the guide and containing element is taken from the first working position to the second inactive position; and a fourth step wherein the metal product is wound from the remainder of its length (Figures 1-3; Column 4, Line 58 - Column 6, Line 2). Bordignon et al. are silent about a second step wherein the metal product is gripped and clamped at least temporarily on the mandrel by means of one or more pincers arranged in correspondence with the outer surface of the mandrel, the one or more pincers further being provided to radially thrust the metal product. However, Fredriksson discloses a method for coiling a long metal product 13 comprising a step wherein the metal product is gripped and clamped at least temporarily on a mandrel 10 by means of one or more pincers 14 arranged in correspondence with the outer surface of the mandrel (Figures 1-6). It would have been obvious to one of ordinary skill in the art at the time of the invention to add the gripping and clamping step with the pincers of Fredriksson to the method of Bordignon et al. to

ensure the initial end of the metal product is gripped as taught by Fredriksson (Column 2, Lines 39 - 52). Regarding Claim 38, Bordignon et al. disclose before the first step, the metal product is inserted into the groove by means of a distributor 45 of the metal product (Figures 1-3; Column 4, Line 58 - Column 6, Line 2). Regarding Claim 39, Bordignon et al. disclose wherein during the first step, the mandrel is in rotation around its own axis (Figures 1-3; Column 4, Line 58 - Column 6, Line 2). Regarding Claim 40, Bordignon et al. disclose during the first step the metal product is guided from the groove inside an annular channel (between the outer surface of 25 and the bottom of the inner plate behind 24) arranged on a inner plate (behind 24) of the mandrel (Figures 1-3; Column 4, Line 58 - Column 6, Line 2).

Claims 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bordignon et al. (US-6318660) in view of Fredriksson (US-3472461) as applied to claims 21-31 and 37-40 above, and further in view of Moslener (US-3945585). Regarding Claims 32-33, Bordignon et al. disclose wherein a flange 24 is applied on the inner plate substantially perpendicular to the mandrel. Bordignon et al. in view of Fredriksson is silent about the flange being shaped so as to have an annular tooth substantially coaxial with the mandrel, the annular tooth defining an annular channel; and the tooth having a thickness substantially equal to the diameter of the metal product or a multiple thereof. However, Moslener discloses a device for coiling a windable, long, metal product comprising a tooth 6 substantially coaxial with the mandrel, the tooth defining a channel 10; and the tooth having a thickness substantially equal to the diameter of the metal product or a multiple thereof (Figure 1). It would have been

obvious to one of ordinary skill in the art to add the tooth of Moslener in an annular form thereby forming an annular channel in the device of Bordignon et al. in view of Fredriksson (US-3472461) to more securely hold the metal product. Regarding Claim 36, Bordignon et al. discloses the flange is made of material of great hardness (as it is made of wear resistant materials) (Figures 1-3; and Column 4, Lines 23-26).

With respect to claim 34, Bordignon et al. in view of Fredriksson and Moslener does not disclose specific values for the protrusion of the annular tooth. However, one of ordinary skill in the art is expected to routinely experiment with the parameters, especially when the specifics are not disclosed, so as to ascertain the optimum or workable ranges for a particular use. Accordingly, it would have been obvious through routine experimentation and optimization, for one of ordinary skill in the art to make the protrusion of the annular tooth between 1.5 and 2 times the diameter of the metal product to secure the first few layers rather than just the first layer.

Regarding Claim 35, Bordignon et al. in view of Fredriksson and Moslener are silent about the flange being interchangeable according to the size of the metal product. However, one of ordinary skill in the art at the time of the invention would recognize the obvious design choice to make the flange interchangeable to easily replace them when they wear out.

Response to Arguments

With respect to Applicant's arguments starting on page 8, line 7 to page 9, line 3, Applicants argue that a copy of JP62275980A has been submitted. Applicant's

arguments have been fully considered but they are not persuasive. Only a copy of a translated abstract, not a complete copy of JP62275980A was submitted.

With respect to Applicant's arguments starting on page 11, line 18 to page 14, line 11, Applicants argue the combination of Bordignon et al. and Kogos et al. does not disclose or suggest a clamping device with a pincer means that at least temporarily clamps an initial segment of the wire. Applicant's arguments with respect to claim 21 and 37 have been considered but are moot in view of the new ground(s) of rejection.

With respect to Applicant's arguments starting on page 14, line 12 to page 15, line 13, Applicants argue the combination of Bordignon et al. and Kogos et al. does not disclose or suggest the pincer radially thrusting the metal product. Applicant's arguments with respect to claim 21 and 37 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment, including the addition of the limitation, "said pincer means being provided to radially thrust said metal product" to Line 11 of Claim 21, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM E. DONDERO whose telephone number is (571)272-5590. The examiner can normally be reached on Monday through Friday 6:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. E. D./
Examiner, Art Unit 3654
/Peter M. Cuomo/
Supervisory Patent Examiner, Art Unit 3654